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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/221,931	12/28/98	TSURUO	WAKAB37.001A

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EXAMINER
BURIN, M

ART UNIT	PAPER NUMBER
1654	11

DATE MAILED: 09/29/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/221,931

Applicant(s)

Tsuruo et al

Examiner

M. Borin

Group Art Unit
1654



☒ Responsive to communication(s) filed on Jul 13, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 11 and 17-20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 11 and 17-20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7

☐ Interview Summary, PTO-413.

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Status of Claims

The Examiner acknowledges the preliminary amendments and response to restriction requirement. Claims 1-10, 12-16 are canceled. Claim 11 is amended. Claims 17-20 are added. Claims 11, 17-20 are pending.

Information Disclosure Statement

Applicants' Information Disclosure Statement filed 4/8/99 has been received and entered into the application. Accordingly, as reflected by the attached completed copies of forms PTO-1449, the cited references have been considered.

Claim Rejections - 35 U.S.C. § 102.

The following is a quotation of the appropriate paragraphs of 35 U.S.C.102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 11, 17-20 are rejected under 35 U.S.C. 102(a) as clearly anticipated by Naasani et al (Biochem. Biophys. Res. Comm., 249, 391-396, 1998). The Naasani reference is prior art since it is published within one year of the present application (filed 12/28/98) by "another" (e.g., an authorship entity different from the inventive entity of the present application). The reference teaches that tea catechins, particularly EGCG, a major tea catechin, inhibit telomerase in solution and in intact

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cells. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15. Applicant can overcome the rejection by "perfecting" foreign priority by providing a certified copy and English translation of the priority document which satisfied the requirement for priority under 35 U.S.C. Section 120.

Conclusion.

No claims are allowed

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (703) 305-4506. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael Woodward, can be reached on (703) 308-4028. The fax telephone number for this group is (703) 305-3014.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

September 23, 1999

mlb



MICHAEL BORIN, PH.D
PATENT EXAMINER